REMARKS

Claims 1-19 are pending in the present application. Claims 7, 8, 15, 16, 18 and 19 have been amended herewith. Reconsideration of the claims is respectfully requested.

I.   35 U.S.C. § 112, Second Paragraph

The Examiner rejected Claims 7, 8, 15, 16, 18 and 19 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, which applicants regard as the invention. This rejection is respectfully traversed.

In rejecting Claim 7, the Examiner states that the claim language is not clearly understood as it is not clear as to the requests and the direction of the requests. Applicants have amended such claim to further clarify these identified concerns, and thus this rejection has been overcome.

In rejecting Claim 8, the Examiner states that it is not clear as to the meaning of "the copy of said file piece on the client machine being the result of a previous request for the file piece from the client machine to the server and receipt of the file piece from the server to the client machine". Applicants have amended such claim in an attempt to address this concern, and it is thus urged that Claim 8 clearly recites the claimed methodology.

With respect to Claim 15, such claims have been amended to clearly recite that the instructions are executed by a second client machine to further make clear the context of the requests and the direction of requests.

With respect to Claim 16, such claim does not recite any of the objectionable language identified by the Examiner in rejecting Claims 7 and 8, and no further reason is given by the Examiner for the rejection of Claim 16. Thus, it is urged that Claim 16 is not unclear as reciting the objectionable language identified for either Claim 7 or 8, as it does not recite such objectionable language.

With respect to Claims 18 and 19, Applicants traverse for similar reasons to those given above with respect to Claims 7 and 8.

Therefore the rejection of Claims 7, 8, 15, 16, 18 and 19 under 35 U.S.C. § 112, second paragraph has been overcome.

II.   35 U.S.C. § 103, Obviousness

The Examiner rejected Claims 1-19 under 35 U.S.C. § 103 as being unpatentable over Oren et al. (US Patent Application No 2003/0145093), in view of Boykin (US Patent Application No 2002/0078461). This rejection is respectfully traversed.

The effective filing date of the cited Oren reference is 11/12/2002, which is more than one (1) year later than the filing date of the present application, which is 06/25/2001. Although the Oren reference alludes to a provisional application, the cited Oren reference is not entitled to the filing date of this provisional application as the non-provisional Oren application was not filed within 12 months of the filing date of the provisional Oren application, and hence the requirements of 35 U.S.C. 119(e) were not properly met[1]. Thus, the cited Oren reference is not a proper 35 U.S.C. § 103 reference with respect to the current application. Claim 1 is thus shown to have been erroneously rejected using a reference having an effective filing date that is after the effective filing date of the present application.

Still further with respect to Claim 1, the Examiner cites Boykin as teaching certain claim elements. In particular, the Examiner states that Boykin teaches two 'request receive' operations that are not taught by Oren. Applicants urge that Claim 1 recites certain synergistic co-action between certain recited steps, and this synergistic co-action is not taught or suggested by the cited references. Specifically, Claim 1 recites (1) receiving a request for said file piece from a second client machine; and (2) *if said file piece requested from the second client machine* (per (1), and hence the synergistic co-action) *has previously been downloaded to the first client machine responsive to the request for said file piece from the first client machine*, redirecting the request of the second client machine to the first client machine. As can be seen, synergistic co-action exists between the 'receiving a request' step and the 'redirecting' step, where the redirecting step is conditioned upon a particular condition of whether said file piece requested from the second client machine (per (1)) has previously been downloaded to the first client machine responsive to the request for said file piece from the first client machine. In rejecting this conditional redirection aspect of Claim 1, the Examiner states that Oren teaches 'the client

---

[1] Per MPEP 706.02 V. (D), which describes the effective filing date of an application, if the application properly claims benefit under 35 U.S.C. 119(e) to a provisional application, the effective filing date is the filing date of the provisional application for any claims which are fully supported under the first paragraph of 35 U.S.C. 112 by the provisional application.

Page 8 of 11
Jones et al. — 09/888,473

locates a file of interest which is stored at a peer device'. Applicants respectfully submit that even if Oren were a valid reference (which it is not), a teaching of locating a file of interest does not teach or otherwise suggest any determination as to whether such file has previously been downloaded to the first client machine responsive to a request for the file from the first client machine, as expressly required by Claim 1, and then conditionally redirecting the request based upon this conditional determination. This conditional redirection of the request of the second client machine is not taught or suggested by any of the cited references - the condition for such redirection being if said file piece requested from the *second* client machine has previously been downloaded to the *first* client machine responsive to the request for said file piece from the *first* client machine. Thus, even when using an improper 35 USC 103 reference, there are still missing claimed features not taught or suggested by the cited references -- strongly evidencing non-obviousness.

Applicants traverse the rejection of Claims 2-6 for reasons given above with respect to Claim 1.

Applicants initially traverse the rejection of Claim 7 for reasons given above with respect to Claim 1 and the improper use of the cited Oren reference in a 35 USC 103 rejection.

Still further, in rejecting Claim 7, the Examiner merely relies on the reasoning given in rejecting Claim 1 as the sole basis for rejecting Claim 7 under 35 USC 103. Applicants urge that since the scope of Claim 7 is different from Claim 1, and recites different steps not recited in Claim 1 (such as receiving a request that is redirected from the server, and the sending step), the Examiner has failed to establish a prima facie showing with respect to Claim 7 as there are claimed features not even alleged to be taught or suggested by the cited references[2]. Accordingly, the burden has not shifted to Appellants to rebut such improper obviousness assertion[3]. It is thus shown that Claim 7 has been improperly rejected under 35 USC 103[4].

---

[2] To establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03. *See also, In re Royka*, 490 F.2d 580 (C.C.P.A. 1974).

[3] In rejecting claims under 35 U.S.C. Section 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). Only if that burden is met, does the burden of coming forward with evidence or argument shift to the applicant. Id.

[4] If the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

Page 9 of 11
Jones et al. – 09/888,473

Applicants initially traverse the rejection of Claim 8 for reasons given above with respect to Claim 1 and the improper use of the cited Oren reference in a 35 USC 103 rejection.

Still further, in rejecting Claim 8, the Examiner relies on the reasoning given in rejecting Claim 7. Applicants urge that the amendment to Claims 7 and 8 now clearly distinguish the scope, and differences, between these two claims with Claim 7 being directed to the machine that is providing the subsequently requested file piece, and Claim 8 being direct to the machine that requests and receives the subsequently requested file piece.

Still further regarding Claim 8, such claim has been amended to further emphasize the highly automated nature of obtaining distributed information, in that the machine desiring the information (the first machine) sends a request to one device (a server) and receives the requested information from another device (the second machine) without further request by the first machine – i.e. in a transparent fashion. In contrast, the teachings of Boykin describe a system whereby the requesting client is intimately involved in locating the individual requested pieces from each of a plurality of different servers (page 4, paragraph [0035]). Thus, it is further urged that Claim 8 is not obvious in view of the cited references.

Applicants traverse the rejection of Claims 9-14 for similar reasons to those given above with respect to Claim 1.

Applicants traverse the rejection of Claim 15 and 18 for similar reasons to those given above with respect to Claim 7.

Applicants initially traverse the rejection of Claim 16 and 19 for reasons given above with respect to Claim 8.
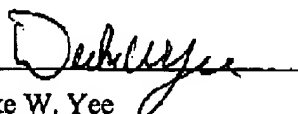
Therefore, the rejection of Claims 1-19 under 35 U.S.C. § 103 has been overcome.

III. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: January 30, 2006

Respectfully submitted,

Duke W. Yee
Reg. No. 34,285
Wayne P. Bailey
Reg. No. 34,289
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorneys for Applicants